

REMARKS

This amendment is filed in response to an office action mailed November 4, 2004 in which the Examiner (a) withdrew from consideration claim 68 and (b) rejected claims 1-57 under 35 U.S.C. §103(a) as unpatentable over U.S. patent serial number 6,108,688 (“Nielsen”) in light of U.S. patent serial number 6,426,955 (“Gossett Dalton, Jr.”).

In order to streamline the prosecution of the present application, the applicant has cancelled claims 2 through 4, 6, 7, 9 through 34, 38 through 42, 44, 45, 48, 49, 51, 52, and 54 through 57. Claims 1, 5, 8, 35 through 37, 43, 46, 47, 50, and 53 are currently pending.

The Examiner rejected claims 1-57 under 35 U.S.C. §103(a) as unpatentable over Nielsen in light of Gossett Dalton, Jr.. Each of the remaining independent claims (namely claims 1, 46, and 47) rejected by the Examiner includes a step or a limitation relating to ranking associated contact numbers. Claim 1 includes “prompting a user to rank the associated contact numbers relating to the recipient identified in response to step (b) from highest to lowest”. Claim 46 includes “prompting a user to rank the associated contact numbers relating to the recipient identified in response to step (b) from highest to lowest”. Claim 47 includes “wherein said processor causes a user to be prompted to rank the associated contact numbers relating to the identified recipient from highest to lowest”.

Nielsen is a “system for reminding a sender of an email if recipient of the email does not respond by a selected time set by the sender”. It “provides the sender of an e-mail message with the capability of automatically generating a warning message on the sender’s system if the recipient of the message has not opened the message by a time specified by the sender.” Col. 1, lines 54-58. Nielsen relates purely to e-mail (and

therefore to messages sent by e-mail), although it does provide mention the possibility of using other means of communication such as telephone calls and pages *to notify the sender* that a message has not been delivered. Col. 2, lines 28-30; col. 4, lines 8-13; col. 8, lines 8-17. Contrastingly, the claimed invention is not limited to e-mail, but encompasses messages of many varieties sent through many channels of communication, including e-mail (claim 6), paging (claim 7), automated telephone call (claim 8), and facsimile (claim 10).

While the Examiner acknowledges that Nielsen does not teach or suggest ranking associated contact numbers, the Examiner suggests that Nielsen may be combined with Gossett Dalton Jr. to supply this claim limitation. Gossett Dalton, Jr. teaches a centralized routing engine that can accommodate preferences (such as price and delay) in routing calls over IP networks.

The Examiner concludes “[t]herefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the system for obtaining responses to messages of Nielsen by prompting a user to rank the associated contact numbers because the sender may know which contact numbers the recipient is more likely to be able to be reached at thus decreasing response time because there will be fewer loops through the contact list before the recipient responds to the message thus making the system more efficient.”

The first problem with this explanation is that while an argument can be made that Gossett Dalton, Jr.’s teachings relating to ranking gateways in terms of preferences regarding price schedules or maximum call delays constitutes ranking associated contact numbers, Gossett Dalton, Jr. clearly does not teach ranking associated contact numbers

on any basis that would aid provide any benefit with respect to Nielsen's invention. The Examiner did not cite any teaching of Gossett Dalton, Jr. relating to assisting in obtaining a response to a message or verifying the receipt of a message or a call.

More significantly, the inventions of Nielsen and Gossett Dalton, Jr. are incompatible with each other. Nielsen deals with e-mail sent over the Internet. The sender of such e-mail is unable to select the path by which it is sent or any gateway that is used. Gossett Dalton, Jr. deals with the selection of what gateway is used to transmit a call. While the call is transmitted over the Internet, it is the selection of the gateway that is the issue. There is simply no need to verify receipt of the call because both parties know whether the call has gone through. The two inventions deal with different problems in incompatible ways.

Most significantly, combining the two inventions would yield no benefit. Nielsen teaches that if an e-mail message is not delivered in a timely fashion, the *sender* optionally receives a notification (Nielsen, col. 8, lines 8-17). However, because it is the sender who is being prompted "to identify a recipient, the recipient having a plurality of associated contact numbers" in claim 1, for example, the fact that the sender may have a plurality of associated contact numbers is irrelevant. Nielsen also mentions that optionally the message is resent to the recipient by other means *through a dialog box that appears after a message has not been delivered in a timely fashion*. (Nielsen, col. 8, lines 8-37). Nielsen does not teach or suggest storing multiple associated contact numbers for message recipients. And even if Nielsen did teach storing multiple associated contact numbers, there is not necessarily a need in Nielsen to receive an actual message in response from a recipient after resending a message by alternate means. For example, if

a facsimile is sent, a facsimile receipt is generated automatically. If a telephone call is sent, a message may be left if no one answers the call. Nielsen does not teach or suggest requiring an actual response to the resent message.

With respect to claims 35-37, Nielsen does not disclose or suggest “converting a verbal message provided by the sender in response to step (a) into textual form”. Column 3, lines 18-26 relate to a description of a user interface for use by a sender in selecting e-mail message non-delivery warning options. This section of Nielsen discloses the use of “voice-activated commands” to select such options. Voice-activated commands are not equivalent to converting verbal messages to text, which typically poses much greater difficulties.

With respect to claim 43, Nielsen does not suggest or disclose a message provided by a sender wherein the message comprises a plurality of questions and the recipient is prompted to provide an answer to each question in the sender’s message. The cited passage of Nielsen discloses questions that are not part of the sender’s message and are not provided to the recipient. Nielsen does not disclose prompting the recipient with respect to such questions.

For the above reasons, the applicant believes that claims 1, 5, 8, 35 through 37, 43, 46, 47, 50, and 53 are allowable over the prior art of record, and requests that a timely Notice of Allowance be issued.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Ethan Civan", is written over a horizontal line.

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